

REMARKS

Claims 1-48 and 50-53 are pending. Claims 1-10 and 20-39 were previously cancelled, and claims 11-19, 40-48, and 50-53 stand rejected. By virtue of this response, no claims are cancelled, claim 11 has been amended, and no claims have been added. Support for the amendment to claim 11 may be found in Figs. 5A and 5B, for example. No new matter has been added by the amendment. Accordingly, claims 11-19, 40-48, and 50-53 are currently under consideration.

Cancellation and amendment of certain claims is not to be construed as a dedication or abandonment of any unclaimed subject matter by Applicants, and moreover Applicants have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants explicitly reserve the right to pursue prosecution of any subject matter in continuation and/or divisional applications.

Claims Rejected under 35 USC §103

A. Claims 11-12, 14-15, 17-19, 40-41, 43-44, 46-48, and 50-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,932,045 to Campbell et al. (hereinafter "Campbell") in view of U.S. Patent No. 5,606,433 to Yin et al. (hereinafter "Yin"), and further in view of U.S. Patent No. 6,434,299 to Yudin et al. (hereinafter "Yudin").

Applicants respectfully submit that the combination of references fails to disclose or suggest the specific features of claim 11 as amended. In particular, the references taken alone or in combination fail to disclose or suggest a multilayer optical article including "a reflective layer disposed between the first substrate and the third substrate," as recited by claim 11. Claim 40 further recites a similar position of the "reflective surface," between substrates in a multilayer optical article. Accordingly, the rejection should be withdrawn and the claims allowed.

The Applicants further assert that even assuming the references are properly combined the references fail to disclose or suggest the particular placement of a reflective layer between the first and third substrate as recited by amended claim 11 and maintain that the Examiner has failed to

present a *prima facie* case of obviousness. The Examiner states in the on Page 4 of the final Office Action mailed 9/7/2004 (and similarly on page 5 of the previous Office Action mailed 3/16/2004):

...Yudin provides wavelength division multiplexing having diffraction gratings for optical elements such as holograms and substrates such as glass and plastic. See col. 8, lines 34-46 where Yudin teaches the following: Reflective concave diffraction grating 16 can be formed from a variety of ;materials and by a variety of techniques. For example, the reflective concave diffraction grating 16 can be formed by a three-dimensional hologram in a polymer medium, or by replicating a mechanically ruled master with a polymer material. In both cases, the polymer is overcoated with a thin, highly reflective metal layer such as, for example, gold or aluminum. Alternatively, the reflective concave diffraction grating 16 can be formed by chemically etching into a concave material such as, for example, glass or silicon, which is also overcoated with a thin, highly reflective metal layer such as, for example, gold or aluminum. Such teaching is equivalent to providing reflective layers of gold or aluminum on substrates as required by instant claims 49-53. It would have been obvious to one of ordinary skill in the art to include reflective layers of gold or aluminum on substrate and to contain diffractive grating because Yudin teaches the application for forming three-dimensional holograms as cited above. (Emphasis added).

Applicants respectfully disagreed with the rejection in their responses filed June 15, 2004 and November 8, 2004. The Applicants submitted, *inter alia*, that the combination of Campbell, Yin, and Yudin fails to disclose or suggest a multilayer optical article having “a reflective layer,” in combination with other features as recited in claim 11 for a number of reasons. Applicants reassert those arguments herein. The Applicants further assert that the references fail to disclose or suggest the particular placement of the reflective layer between the first and third substrate as recited by amended claim 11.

In response to Applicants previous remarks filed November 8, 2004, the Advisory Actions states “[h]owever, the primary and secondary references teach multilayered optics, the tertiary [sic] reference was not used to teach multilayer articles, but the mere addition of a reflective surface in the optical technology for producing a three-dimensional type holograms.” The addition of Yudin, however, fails to disclose or suggest the addition of a reflective surface between substrates of a multilayer article as presently claimed. The disclosure of a reflective overcoat layer by Yudin (see, e.g., col. 8, lines 40-42) appears to suggest (at best) a reflective coating on an outer

surface of an optical article, but clearly does not suggest the desirability of a reflective layer disposed between substrates in a multilayer optical article. Accordingly, the Examiner has failed to find a teaching, suggestion, or motivation in the prior art for the proffered combination and modifications to meet the features of the present claims and appears to be resting on the assertion that one could combine the references. Such a basis for an obviousness type rejection is clearly inadequate, and is inadequate precisely to guard against hindsight analysis – the fact that references can be combined is insufficient, “the prior art must suggest the desirability of the claimed invention.” MPEP 2143.01; *In re Mills* 916 F.2d 680 (916 F.2d 680) (Emphasis added). Therefore, the rejection should be withdrawn because the Examiner has failed to establish a suggestion, teaching, or motivation in the prior art such as a specific understanding or technical principle that would have suggested a combination to meet the particular features of claim 11. See, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); MPEP §§ 2142, 2143.01.

Furthermore, the assertion that Yudin discloses a reflective layer does not provide any teaching, suggestion, or motivation to combine the reference teachings, let alone to modify the disclosures of Campbell and Yin to meet the features of the present claims. That is, the disclosure by Yudin of a concave diffraction grating formed by a three-dimensional hologram, without more, does not suggest why one of ordinary skill in the art would combine and modify the references to include a reflective layer disposed between substrates of a multilayer article. For example, a reflective coating of a concave diffraction grating formed by a three-dimensional grating in a polymer medium does not provide a teaching, suggestion, or motivation to one skilled in the art to include a reflective layer between substrates in a multilayer optical article (or suggest the desirability of such a multilayer optical article).

Accordingly, for at least these reasons, Applicants request that the rejection be withdrawn and the instant claims be allowed.

B. Claims 16 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Yin and Yudin and further in view of U.S. Patent No. 4,921,319 to Mallik.

Claims 16 and 45 depend from claims 11 and 40 respectively, and should be allowable for at least similar reasons detailed above. Accordingly, Applicants request withdrawal of the rejection.

C. Claims 13 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Yin, and further in view of U.S. Patent No. 6,671,073 to Hegel.

Claims 13 and 42 depend from claims 11 and 40 respectively, and should be allowable for at least similar reasons detailed above. Accordingly, Applicants request withdrawal of the rejection.

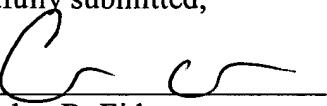
CONCLUSION

If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 495812001900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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